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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,369	12/20/2001	Jarett Rinaldi	219.40436X00	3460

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EXAMINER

VORTMAN, ANATOLY

ART UNIT PAPER NUMBER

2835

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,369

Applicant(s)

RINALDI ET AL.

Examiner

Anatoly Vortman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 8 is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 June 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on 07/22/03 (paper #10) after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/25/03 (paper # 8) has been entered.

Specification

2. The disclosure is objected to because of the following informalities: specification as amended refers to a "connector" (30) as to a "switch" (see p. 2, lines 13+ of the Applicant's amendment filed on 06/25/03 (paper # 8)). Appropriate correction is required.

Drawings

3. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The proposed drawings correction filed on 06/25/03 has been disapproved by the Examiner.

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Also, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the single connector lead connected to a plurality of leads/traces contained within the printed circuit board as recited in claims 6, 7, 9, 13, and 16 must be shown. No new matter should be entered. Please note, that Fig. 7 shows that only single connector leads entering the connector (30).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 6, 7, 9-12, and 13-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 6 and 7, claims recite that "a plurality of lead/traces connected to a connector lead of the at least one connector leads";

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Regarding claims 9-12, claim 9 recites that "a single connector lead...is connected to a positive thermal coefficient switch and is connected to a plurality of lead/traces contained within the printed circuit board";

Regarding claims 13-15, claim 13 recites that "a single connector lead...is connected to a positive thermal coefficient switch and is connected to a plurality of leads/traces contained within the printed circuit board".

Regarding claims 16-18, claim 16 recites: "one connector lead to connect the at least one connector port to a plurality of lead/traces of the printed circuit board".

The specification does not provide any explanation how the present invention is supposed to work as claimed in the aforementioned claims.

The specification of the instant application teaches regarding Fig. 7 (p. 12 of the Applicant's amendment filed on 04/01/03 (paper # 6)) that "certain lead/traces 40 connect to a common connector lead contained within switch {sic} 30. Therefore, a single positive thermal coefficient switch may be placed...to support multiple leads/traces 40...".

It is not clear how the Applicant's invention as claimed in the aforementioned claims is supposed to work. The Applicant is suggesting to effectively short out various circuits before connecting to a single protective device (i.e. a single positive thermal coefficient switch). That is defeating the purpose of providing individual protection for individual circuits of the device. Also the shorting out different circuits of the device in order to protect said circuits by a single positive thermal coefficient switch would effectively render the device of the present invention inoperative.

Allowable Subject Matter

6. Claims 1-5, and 8 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:
regarding claims 1-5 and 8, claims 1 and 8 recite: "at least one positive thermal coefficient switch provided as part of the connector on an exposed exterior surface of the connector". The aforementioned limitations in combination with remaining limitations of the claims are believed to render claims 1-5 and 8 patentable over the art of record.

Response to Arguments

8. Applicant's arguments provided in amendment filed on 06/25/03 have been fully considered but they are not persuasive.

The main thrust of the Applicant's arguments is directed to the assertion that there was no intention on the Applicant's part to admit a prior art in the "Background" section of the instant application. Specifically, the Applicant has stated that "background devices discussed in the "Background" may have been developed one day prior to the filing day of the present application and by the inventors of the present application" (p. 7, lines 2+ of the amendment). Thus, the Examiner requests the Applicant to provide evidence of the aforementioned facts or an appropriate affidavit. Also, please note that an admission (of prior art) is a fact acknowledged, declared, connected, or recognized by an Applicant or his attorney. *Ex parte McGaughey*, 6

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USPQ2d 1334, 1338 (Bd. Pat. App. & Int. 1988). Hence, the "Background" section of the instant application and the drawings referred to in the "Background" section have been considered by the Examiner accordingly (see MPEP 608.01 (c), subsection (2)).

Regarding the drawings, the Applicant's arguments that the verb "should" is not to be construed as a requirement for the drawings to be labeled "Prior Art" (see p. 2, lines 1+ of the Amendment filed on 06/25/03), please note that Office Action explicitly states that: "A proposed drawing correction or corrected drawings **are required** (emphasis added)". The MPEP does not provide any alternatives to the Applicant, but only to label the figures "Prior Art" if **only what is old** is depicted on the figures. And since Fig. 1-3 of the instant Application depict **only what is old** they **must** be labeled "Prior Art" (See MPEP § 608.02(g)).

In conclusion, the Examiner would like to direct the Applicant's attention to the "Webster's II New Riverside University Dictionary" which defines the verb "shall" as following: "a. Determination or promise; b. Inevitability; c. Command; d. A directive or requirement."

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on Monday-Friday, between 9:30am and 6:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A.V.

A handwritten signature in cursive script, appearing to read "A. Vortman".

— Anatoly Vortman
Primary Examiner
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